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EXAMINER	
DI MAURO,P	
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Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition , and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 9/24/97 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

   a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

   b. ☐ They raise new issues that would require further consideration and/or search. (See Note).

   c. ☐ They raise the issue of new matter. (See Note).

   d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

   e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

   Claims allowed: none
   Claims objected to: none
   Claims rejected: 45-84, 96, 181, 203-231

   However;

   ☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because of reasons set forth on attached page

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficent reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☒ Other Note Attached Examiner Interview Summary Record + Form PTO-892

PTOL-303 (REV. 5-89)

An appeal under 37 CFR 1.191 was filed in this application on 26 September 1997. Appellant's brief is due on 26 November 1997 in accordance with 37 CFR 1.192(a).

The amendment filed 26 September 1997 under 37 CFR 1.116 in response to the final rejection has been entered, but is not deemed to place the application in condition for allowance. The request for reconsideration has been entered and considered but does not overcome the rejection(s).

The Declaration by Kratschmer is ineffective to overcome the section 103 rejection over the Kratschmer, Huffman, Fostiropoulos reference because there is rebuttal evidence that Fostiropoulos considers himself a co-inventor (see the book entitled "Perfect Symmetry: The Accidental Discovery of Buckminsterfullerene" by Jim Baggott, at page 279, lines 27-29), and there is evidence that he is more than a co-author.

In paragraphs 4 and 9 of said declaration, Declarant appears to be ascribing the basis for concluding that co-author Fostiropoulos was not a co-inventor, from a source who is neither a Declarant nor a co-author, namely, Applicants' counsel. It is not clear what standard Applicant's counsel applied.

The declaration uses the language from the *In re Katz* (215 U.S.P.Q. 14) decision. It is note that the language used in Katz is limited to where the examiner conceded that the disclaimed coauthors were "involved only with assay and testing features of the invention" (at 215 USPQ 18). It is not clear if Applicant's counsel applied this part of the standard

The holding of *In re Katz* is distinguishable from the facts in the instant case, because in the *Katz* case there was no evidence that the other co-author(s) could be considered more than mere co-authors, whereas in the instant case, there is evidence that the other co-author can be considered more than a mere co-author. This evidence, inter alia, is found on pages 138-139 of the Baggott book, where it is described that Fostiropoulos innovated in the matter of fabrication and use of carbon-13 rods; and on page 150 where it is described that Fostiropoulos innovated in the matter of sublimation of various C60 films.

In response to applicants' query made at page 4, lines 5-19 of the response, please note the following: in the final rejection, a rejection of claim 181 under 35 USC 112, second paragraph was made. As applicants have correctly surmised, reference was being made to the meaning of the word "amounts", as it appears in the following claimed phrase: "C60 molecules being present in said sooty carbon product in amounts capable of extracting therefrom said C60 in solid form".

Applicants argue that claim 181 recites that C60 is present in amounts "that could be seen with the human eye". However, the claim never states that the amount is one which "could be seen with the human eye"; it merely states that the amount is such that the C60n can be extracted in "solid form".

Applicants argue that the claim language in claims 83, 84, and 222 with respect to amounts of C60 sufficient to impart color to a benzene solution thereof, constitutes an "objective test", and therefore the claim is clear. However, the questions raised in the final rejection has not as yet been answered. "Would a metric ton of "sooty carbon product" containing a gram of C60

(i.e., a ppm C60 concentration) and extracted with a liter of solvent, be within the scope of the claims, (since quantities on the order of one gram C60 can impart color to solvent quantities on the order of one liter)?" It is not yet clear whether applicants' claims distinctly and particularly point out what they intend to regard as the invention. What precisely are the steps of extraction into benzene which constitute this "objective test"?

Applicants strongly disagree that there is no adequate descriptive support in the specification for "macroscopic", because "support for this term and concept permeates the specification", implicitly through description of a colored sublimed film of C60, which could only be seen to be colored if it were "macroscopic".

However, as stated in the final rejection, the usage of the term "macroscopic" (for which there is no descriptive or written support) broadens the scope of the original specification and claims; there is no comparable language as broad in the application as filed as the instant limitation. It is an "addition" to the original disclosure to go from a sample of C60 which had its diffraction pattern measured, to a tonnage quantity of pure C60 which is now claimed.

Any inquiry concerning this communication should be directed to Peter DiMauro at telephone number (703) 308-0680.

Michael Lewis
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Patent Examining Group 110

pd
10-24-97